

REMARKS

I. Status of the Claims

Applicant submits this Amendment in reply to the Office Action dated June 23, 2008. Claims 1-3, 7-8, 13, 15-17, 23, 28, 29, 32-37, 40, 44, 48-49, 51, 53-57, 60, 61, and 72-90 are pending in this application, with claims 1, 40, 72, and 84 being independent. By this Amendment, Applicant has amended claims 1, 7, 8, 13, 19, 21, 23, 25, 26, 33, 34, 37, 40, 41, 44, 46, 48, 49, 51, and 52, canceled claims 4-6, 9-12, 20, 45, 47, 50, and 62-71 without prejudice or disclaimer, and added new claims 72-90. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended and new claims, and no new matter has been entered.

In the Office Action dated July 23, 2008, claims 1-13, 15-17, 23, 28, 29, 32-37, 40, 41, 44, 45, 47-51, 53-56, 60 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,299,630 to Yamamoto ("Yamamoto") in view of U.S. Patent No. 2,587,707 to Dever ("Dever"). In so far as the Examiner deems the rejections to apply to the claims as amended, Applicant respectfully traverses for at least the following reasons.

II. Independent Claims 1 and 40 and Their Dependent Claims

Independent claim 1 has been amended to include all of the recitations of former dependent claim 12. Claim 12 and intervening claims 4 and 6 therefore have been canceled.

Independent claims 1 and 40 each recites, among other things, a medical device comprising a handle, an end effector assembly, and an elongate member. The handle includes an elongate portion and a spool portion. The spool portion includes a proximal portion and a distal portion, wherein “a plurality of grooves are defined by the proximal portion and another plurality of grooves are defined by the distal portion, wherein the plurality of grooves are circumferentially aligned with the another plurality of grooves.”

In rejecting independent claims 1 and 40, the Office Action admits that *Yamamoto* “discloses the invention substantially as claimed except for the slider or spool further comprises grooves.” (Office Action at p. 3.) The Office Action then relies on *Dever* for its alleged teachings of a spool including a plurality of grooves. (Office Action at pp. 3-4.) Even assuming the Office Action’s characterizations are correct, a point which Applicant does not concede, *Dever* fails to cure the deficiencies of *Yamamoto*. *Dever* fails to disclose or suggest a **plurality** of grooves defined by the proximal portion and another **plurality** of grooves defined by the distal portion, as recited in claims 1 and 40.

Further, one of ordinary skill in the art would not be motivated to include a plurality of grooves on proximal and distal portions, based on the teachings of *Dever*. As shown in Fig. 2 of *Dever*, for example, electric cord 13 may be “inserted through slot 19 of the second rim 18, the slack 12 wound about the core 15 in a plurality of side-by-side turns, and the cord 13 withdrawn through slot 17 in the first rim 16.” (*Dever*, col. 2, lines 6-10.) Because of the side-by-side winding arrangement in *Dever*, multiple grooves at the proximal and distal portions are not needed. Only a single slot at each

end is needed for entrance and exit of the cord. Dever therefore provides no teaching or motivation for additional slots.

In addition, Dever discloses an electric cord storage device which is non-analogous to the art of medical devices. According to the M.P.E.P., a reference in a field different from that of an Applicant's invention, used as a basis for rejection, "may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." M.P.E.P., § 2141.01(a)(l) *citing KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1397 (2007). Here, an inventor seeking to solve problems with safe packaging, unwrapping, and disposal of a medical instrument would not have turned to the art of electric cord storage.

A fundamental difference between an elongate member of, for example, a long endoscopic medical instrument and an electric cord is that the elongate member typically has resilient or springy properties and cannot be tightly wound. These properties make it difficult to package the elongate member in a tightly wrapped arrangement and can cause the elongate member to whip, or spring, open when unpackaged or being prepared for disposal. Additionally, the distal tip of the elongate member typically includes a medical tool which may be sharp and/or require sterility. Thus, packaging and unwrapping of the medical instrument may further require that the distal tip of the elongate member be prevented from contact with objects and surfaces of its external environment for safety and sterility purposes. A typical electric cord, on the other hand, does not have such properties (e.g. a springy nature, an inability to be tightly wound, or a sharp tip requiring no contact with an unsterile environment).

Therefore, the problems or difficulties encountered for the safe packaging, unwrapping, and disposal of a medical instrument are significantly different than the problems associated with concealing and storing an electric cord in a neat and ornamental appearance. For example, and as shown in Figs. 1 and 2 of *Devers*, electric cord 13 is tightly wound around core 15 of storage spool 11. However, a typical elongate member of a medical instrument would not be capable of being in a tightly wound arrangement for packaging purposes as the resilient and springy properties of the elongate member would cause unwinding and unraveling of the elongate member and potential unsafe and unsanitary contact of the distal tip with its external environment.

Thus, one of ordinary skill in the art of medical devices would not have looked to the art of electrical cord storage devices to remedy the problems associated with the safe packaging, unwrapping, and disposal of medical instruments, as the storage techniques suited for the properties of electric cords would not be appropriate for medical instruments. Accordingly, the rejection is improper because the art of electrical cord storage devices is not analogous to the art of medical instruments and reconsideration is respectfully requested.

Dependent claims 2-3, 7-8, 13, 15-17, 23, 28, 29, 32-37, 41, 44, 48-49, 51, 53-57, 60, and 61 depend either directly or indirectly from either independent claim 1 or 40 and are allowable over *Yamamoto* and *Dever* at least due to their dependence on either independent claim 1 or 40.

III. New Claims

New independent claim 72 recites, among other things, a handle, an end effector assembly, and an elongate, flexible member forming loops, “wherein a first groove defined by the handle houses each of the loops.” At least these claimed features are neither disclosed, taught, nor suggested by *Yamamoto* and *Dever*. No slot in the *Dever* device houses a number of loops.

Further, one having ordinary skill in the art would not be motivated to include a groove housing loops, based on the teachings of *Dever*. As shown in Fig. 2 of *Dever*, for example, the slack 12 of electric cord 13 is “wound about the core 15 in a plurality of side-by-side turns.” (*Dever*, col. 2, lines 7-9.) The *Dever* device “conceal[s] and stor[es] the slack of an electric plug-in cord, which, when applied to said cord, presents a neat and ornamental appearance.” (*Dever*, col. 1, lines 5-8.) Thus, housing a number of loops of the electric cord 13 in slots 17, 19 would render the *Dever* device unsatisfactory for its intended purpose. For example, the *Dever* device would fail to conceal and store slack 12 as electric cord 13 would extend from slots 17, 19 in the form of loops. For at least this additional reason, new independent claim 72 patentable distinguishes over *Dever*.

New independent claim 84 recites, among other things, a handle, an end effector assembly, and an elongate member. The handle defines at least one groove configured to accommodate at least one of a first portion of the elongate member and a portion of the end effector assembly, and “the handle defines at least one notch circumferentially adjacent to the at least one groove and configured to accommodate a second portion of the elongate member.” At least these claimed features are neither disclosed nor

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suggested by *Yamamoto* and *Dever*. For example, no slots in the *Dever* device are circumferentially adjacent.

New dependent claims 73-83 and 85-90 depend either directly or indirectly from new independent claims 72 and 84 respectively and are allowable at least because of their dependence on new independent claims 72 and 84.

IV. Conclusion

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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